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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/535,300	03/24/2000	Alan W. Schwabacher	2003118-0001	2305

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EXAMINER

SHIBUYA, MARK LANCE

ART UNIT	PAPER NUMBER
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1639

DATE MAILED: 12/09/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Advisory Action

Application No.

09/535,300

Applicant(s)

SCHWABACHER ET AL.

Examiner

Mark L. Shibuya

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--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 04 November 2004 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

PERIOD FOR REPLY [check either a) or b)]

- a) ☒ The period for reply expires 5 months from the mailing date of the final rejection.
- b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection. ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☐ A Notice of Appeal was filed on _____. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.
2. ☒ The proposed amendment(s) will not be entered because:
- (a) ☒ they raise new issues that would require further consideration and/or search (see NOTE below);
 - (b) ☒ they raise the issue of new matter (see Note below);
 - (c) ☒ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
 - (d) ☒ they present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: Please see attached.

3. ☒ Applicant's reply has overcome the following rejection(s): Please see attached.
4. ☐ Newly proposed or amended claim(s) ____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
5. ☒ The a) ☐ affidavit, b) ☐ exhibit, or c) ☒ request for reconsideration has been considered but does NOT place the application in condition for allowance because: Please see attached.
6. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.
7. ☒ For purposes of Appeal, the proposed amendment(s) a) ☒ will not be entered or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

Claim(s) allowed: None.

Claim(s) objected to: 65 and 66.

Claim(s) rejected: 65 and 66.

Claim(s) withdrawn from consideration: 53-64 and 67-74.

8. ☐ The drawing correction filed on _____ is a) ☐ approved or b) ☐ disapproved by the Examiner.
9. ☒ Note the attached Information Disclosure Statement(s) (PTO-1449) Paper No(s). 11/4/2004.
10. ☐ Other: _____


PADMASHRI PONNALURI
PRIMARY EXAMINER

Mark L. Shibuya
Examiner
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1. The proposed amended and new claims after final rejection, which state the limitation "a geometric substrate about which the optical fiber is wrapped in a spiral and in a single layer of fiber about the substrate", would require further consideration and search. These limitations also raise the issue of new matter (particularly "in a single layer of fiber about the substrate"). Furthermore, applicant has added more new claims than cancelled claims. Therefore, the proposed amendments to the claims are not entered.

2. In regards to Election/Restriction, the proposed amendments would place the withdrawn claims within the elected invention; however the proposed amendments are not entered (see above).

3. The Information Disclosure Sheet filed 11/4/2004 has been considered. See attached.

4. In regards to the claim objections, applicant's renumbering of the claims is acknowledged. Applicant has not overcome the objections to claims 65 and 66 by the proposed amendments to the claims because the proposed amendments are not entered.

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5. In regards to applicant's traversal of the new matter rejections of claims 65 and 66 under 35 U.S.C. 112, first paragraph, applicant argues that the limitation "so that a larger number of products is produced than different chemical reactions are performed" is supported throughout the specification, such as p. 2, lines 5-26. Applicant refers to "the wide range of chemical compounds one is able to prepare as compared to the number of synthetic steps performed" and applicant states that "a combinatorial library with 25 members can be prepared using just ten reactions . . . whereas fifty reaction would be required to produce the 25 products using traditional one-by-one organic synthesis." Applicant argues that those of skill in the art would "appreciate" this aspect in the combinatorial arts.

These arguments have been considered as persuasive and would overcome the new matter rejection over the limitation "so that a larger number of products is produced than different chemical reactions are performed".

6. In regards to applicant's traversal of the new matter rejections of the claims 65 and 66 under 35 U.S.C. 112, first paragraph, applicant argues that the limitations "wherein members of the library are related to one another by synthetic history" and wherein each member of a first subset is separated from each "next closest member by a first distance" is supported by portions and Figures 1 and 2 of parent application 09/253,153.

Applicant's arguments have been considered but are not considered persuasive in regard to the limitation "wherein members of the library are related to one another by

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synthetic history” and would not overcome the new matter rejection in regards to that limitation. Parent application 09/253,153 and its Figures 1 and 2 do not provide support or direction and guidance for the limitation “synthetic history”.

Applicant’s arguments are persuasive in regard to the limitation wherein each member of a first subset is separated from each “next closest member by a first distance” and would overcome the new matter rejection over this specific limitation because Figures 1 and 2 of parent application 09/253,153 show members of a subset that are separated by a first distance.

7. In regards to applicant’s traversal of the rejections of the claims 65 and 66 under 35 USC 112, second paragraph, applicant’s proposed claim amendments changing “can be generated” to –are generated–, would overcome the rejection. However, the proposed amendments to the claims are not entered (see above).

8. In regards to applicant’s traversal of the rejections of the claims 65 and 66 under 35 USC 112, second paragraph, applicant’s arguments in regard to the rejection of the language “synthetic history” have been considered, but are not persuasive, because the neither the claims nor the specification set forth the metes and bounds of the term.

9. Applicant traverses the rejection of the claims 65 and 66 under 35 USC 102(e) as being anticipated by Stimpson, US 6,037,186. Applicant argues that the reference of

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Stimpson teaches two-dimensional arrays, but does not teach linear one dimensional array of peptides or proteins along an optical fiber.

Applicant's arguments have been considered but are not persuasive. Stimpson at col. 9, line 67-col. 10, line 4, teach one dimensional arrays by cutting into the z-axis; Stimpson at Figures 2A and 2C depict an one dimensional, linear array.

10. Applicant traverses the rejections of the claims under 35 USC 103(a) as being unpatentable over Brown et al., (Anal. Chem. 1996), Pirrung et al. (US Patent No. 5,143,854) and Myers (US Patent No. 4,848,687). Applicant argues that the proposed amendments to the claims would avoid the cited prior art.

Applicant's arguments have been considered but are not persuasive because the proposed claim amendments are not entered.